

REMARKS

STATUS OF CLAIMS AND SUPPORT FOR AMENDMENTS

Upon entry of this amendment, claims 1-7 will be pending in this application.

The amendments to claims 1 and 5 are supported by the specification, *inter alia*, at paragraph [0010] and paragraph [0020]. New claims 6 and 7 are supported by the specification, *inter alia*, at paragraph [0021] - [0023].

No new matter has been added.

CLAIM OBJECTION

In paragraph 3 of the Office action, the Examiner has objected to claim 5, alleging that the terminology "a front edge" in line 22 of the claim should be changed to "the front edge." Applicants respectfully traverse this objection. Line 22 of claim 5 is the first place in claim 5 where the terminology "front edge" is introduced.

Accordingly, the use of the article "a" is believed to be proper under the circumstances.

OBVIOUSNESS REJECTION

In paragraph 4 of the Office action, the Examiner has rejected claims 1-5 under 35 U.S.C. § 103(a) as obvious over Figure 4 of the present application, and page 2, line 23 to page 3, line 21 of the specification of the present application, in view of JP 64-53948 (JP '948). Applicants traverse this rejection for the reasons given below.

The Examiner admits that the description in the present application at Figure 4 and at page 2, line 23 to page 3, line 21 of the specification does not contain a disclosure of a detector, retracting mechanism, or means for retracting the handling

member as recited in claims 1, 5, or 6. See Office action dated May 1, 2008 at page

3. In an attempt to cure this deficiency, the Examiner turns to JP '948, stating:

JP'948 discloses that it is well known to provide a sheet feeder (Figs. 1-2 and 8a-8c) with a handling member (including 120) for allowing only an uppermost sheet carried by a carrier (including 101) to pass the handling member (including 120); a detector (SE3 of Fig. 2) for detecting a front edge of the sheet and a rear edge of the sheet which has passed the handling member and has been put on another carrier, wherein the detector (SE3) is located downstream of the handling member (including 120); and a retracting mechanism (i.e., whatever structure retracts element 120 in Figs. 8a-8c) for retracting the handling member away when the detector detects the front edge of the sheet, and returning the handling member to the operative position when the detector detects the rear edge of the sheet after the detector detects a front edge of the sheet while the detector detects the sheet passing through. The English Abstract of JP'948 explains that the arrangement shown in JP'948 surely prevents the double feeding sheets of paper via detecting the sheet.

Office action dated May 1, 2008 at pages 3-4.

From these alleged disclosures, the Examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Fig. 4 of the instant application with a detector, wherein the detector is located downstream of the handling member (4) of Fig. 4 of the instant application; and a retracting mechanism for retracting the handling member (4) of Fig. 4 and returning the handling member (4), for the purpose of surely preventing double feeding of sheets of paper, as taught by JP'948.

Office action dated May 1, 2008 at page 4.

As Applicants have previously explained, JP '948 disclose a device wherein, after the first sheet is conveyed, the handling pad 120 is separated (retracted away from an operative position) from the conveying belt in order not to convey the second sheet. Thus, when the rear edge of the sheet is detected, the pad 120 is moved into an inoperative position. This structural relationship between the handling pad 120 and the sensor SE3 of JP '948 is the opposite of that of the sheet feeder recited in

claims 1 and 5, where the handling member is retracted away from the sheet while the sheet is conveyed and is moved back to the operative position on detection of the rear end of the sheet. For at least this reason, even if the teachings of JP '948 are combined with the teachings of Figure 4 of the present application in the manner that the Examiner suggests, the claimed invention is not obtained and a *prima facie* case of obviousness does not exist.

In support of the rationale for rejection noted above, and in an attempt to answer Applicants' arguments, the Examiner has also asserted that:

Regarding the recitation "a detector **for detecting a front edge of the sheet and a rear edge of the sheet which has passed the handling member and has been put on another carrier**" in claim 1, the bolded portion of this recitation is a statement of intended use that does not define this recitation over the prior art apparatus of Fig. 4 of the instant application, as modified by JP'948 (emphasis added). More specifically, the detector does not actually have to detect the front and rear edges of the sheet, since this is merely a statement of intended use of the detector.

Office action dated May 1, 2008 at pages 4-5. However, claims 1 and 5 each recite the feature that the detector is located on the sheet feeder at a location for detecting the front and rear edges of the sheet. Accordingly, the recitation of the interaction of the detector with the front and rear edges of the sheet is not a "statement of intended use" as suggested by the Examiner, but a recitation of a structural feature of the claimed sheet feeder, since the feature now relates to the location of the detector.

Moreover, the claim language quoted and emphasized by the Examiner is incorrect. The claims recite a detector at a location for detecting the front and rear edges of a sheet that has been placed on the oblique carrier. The Examiner has not explained which structure in JP '948 corresponds to this oblique carrier, and if such structure is not present, why one of ordinary skill in this art would expect to be able

to use the detector of JP '948 with the alleged oblique carrier of Figure 4 of the present application.

The Examiner also asserts:

Regarding the recitation "a retracting mechanism for **retracting the handling member away from an operative position adjacent the sheet passing the handling member when the detector detects the front edge of the sheet, and returning the handling member to the operative position when the detector detects the rear edge of the sheet after the detector detects a front edge of the sheet while the detector detects the sheet passing through**", the bolded portion of this recitation contains "conditional limitations" that need not ever occur. (emphasis added). As mentioned above, the recited detector does not actually have to detect the front and rear edges of the sheet. Rather, this is a statement of intended use of the detector. With regard to the recited "retracting mechanism", if the detector never detects the front edge of the sheet, the retracting mechanism need not retract the handling member. Similarly, if the detector never detects the rear edge of the sheet, the retracting mechanism need not return the handling member. In other words, the "retracting mechanism" limitation does not distinguish claim 1 from the prior art apparatus of Fig. 4 of the instant application, as modified by JP'948, because of the "conditional limitations that need not ever occur. Thus, this combination of references meets the limitations of claim 1 as now amended.

Office action dated May 1, 2008 at page 5.

Applicants respectfully submit that claim 1 does not now contain any "conditional limitations" as the Examiner has asserted. Since Examiner has indicated that the presence of the "conditional limitations" is the basis for his assertion that the retracting mechanism feature of claims 1 and 5 fails to distinguish from the cited references, the removal of any alleged "conditional limitations" should also remove the Examiner's objection. Applicants submit that claims 1 and 5 recite features relating to the response of the retracting mechanism to the state of the detector, and thus the interrelated nature of these elements of the claimed sheet

feeder. As such, claims 1 and 5 recite structure, and not "statements of intended use" as the Examiner alleges.

With respect to the Examiner's assertion that the recitation "a retracting mechanism for retracting the handling member away from an operative position" is a statement of intended use, Applicants note that this recitation no longer appears in claim 1. Moreover, Applicants respectfully submit that JP '948 does not disclose a handling member that is retractable to a non-operative position and returnable to an operative position by a retracting mechanism in response to detection by the detector.

Moreover, with respect to claim 6, which recites "means for retracting," the Examiner has not shown that the structure of handling pad 120 is the same as, or equivalent to, the structure disclosed in Applicants' specification as for the retracting mechanism. Applicants respectfully submit that claim 6 is therefore separately patentable, irrespective of the Examiner's disposition of claims 1-5 and 7.

Applicants respectfully submit that, for at least the reasons given above, the Examiner has not established a *prima facie* case of obviousness of claims 1-7, and as a result, this rejection should be withdrawn. An early notice of allowance is respectfully requested.

In the event that the Examiner does not allow the application, the Examiner is respectfully requested to contact the undersigned to arrange for a telephonic interview in order to expedite prosecution prior to the issuance of another Office action.

Respectfully submitted,

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